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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,244	03/07/2007	Ulrich Werner	WERNER	5446
20151 7590 10/21/2010 HENRY M FEIEREISEN, LLC HENRY M FEIEREISEN 708 THIRD AVENUE SUITE 1501 NEW YORK, NY 10017				
EXAMINER				
MARSH, STEVEN M				
ART UNIT		PAPER NUMBER		
3632				
NOTIFICATION DATE		DELIVERY MODE		
10/21/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

INFO@FEIEREISENLLC.COM

Office Action Summary

Application No.

10/595,244

Applicant(s)

WERNER, ULRICH

Examiner

STEVEN M. MARSH

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

This is the second office action for US Application 10/595,244 for a Method and Device for Altering the Vibration Characteristics of a Motor System. This is a supplemental action to the action mailed October 6, 2009, as discussed in the interview of January 8, 2010.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant claims "that at least a first mounting system (11) can be exchanged against a second mounting system (12) of a different type". However, it is unclear what Applicant considers to be the first mounting system. Applicant describes the mounting system 12 in figure 2 and paragraph 31 of the specification, but though the mounting system 11 is indicated in figure 1, there is no mention of what the mounting system comprises or how it functions. The claims are being examined to the best extent possible.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16, 19-24, and 29-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. These claims are omnibus type claims. Applicant claims that "at least a first mounting system (11) can be exchanged against a second mounting system (12) of a different type". However, as mentioned about, it is not clear what the first type of mounting system is and therefore the claim is indefinite. There are a number of various mounting systems and any of them could be encompassed by the claim language. Also, in claim 16, Applicant claims a machine system, but also claims a method for altering the vibration characteristics of the machine system. Because the claim is claiming the structure of the machine system, the claims will be treated as a structural claim with those limitations examined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15-17 and 21-27 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,960,899 to Roach. Roach discloses a machine system with an electric machine (14... the frame of a vehicle, which has electric components) and an add-on module (28, 34) mounted on the electric machine by a mounting system (32) characterized in that at least a first mounting system can be exchanged against a second mounting system of a different type, wherein a change in the vibration characteristic of the machine system can be achieved by an exchange (one could exchange a harder rubber for the rubber isolators 32, which would change the vibration characteristics). The machine system has different mounting locations (anywhere along the frame can be a mounting location) for mounting the add-on module on the electric machine by using mounting systems, wherein the mounting locations are only partially occupied by a mounting system (if the entire area comprises mounting locations, only 4 are occupied), wherein a change in the vibration characteristic of the machine system can be achieved with the mounting systems by changing occupation of the mounting locations (by mounting other mounting systems the vibration characteristic would change). The mounting system is implemented as a damper and the coupling element comprises a rubber material that absorbs vibration. The add-on component is a top mounted cooler (28) of the electric machine and is attached to the machine by left and right mounting systems.

Claims 15 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,460,822 to Lee. Lee discloses a machine system with an electric machine (300) and an add-on module (200) wherein the add-on module is mounted on

the electric machine by a mounting system (311) characterized in that at least a first mounting system can be exchanged against a second mounting system of a different type, wherein a change in the vibration characteristic of the machine system can be achieved by an exchange (using screws 311 of a different size, shape, or material will change the vibration characteristics). The mounting system (311) includes a coupling element that is a screw connection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roach in view of Official Notice provided by the Examiner. The Examiner is providing official notice that spring and damper combinations are well known vibration isolation systems in the art. Because both Roach and the prior art disclose vibration isolation systems, it would have been obvious to one skilled in the art to substitute one isolation system for the other to achieve the predictable result of a spring and damper mounting system or coupling element.

Claims 16 and 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roach. Roach does not specifically disclose replacing a first mounting system with a second mounting system. However, Roach discloses that the mounting systems (32)

can be either elastic or rubber isolators. Therefore, the specific material is a matter of design preference that would be obvious to one of ordinary skill in the art, and one of ordinary skill in the art would know to utilize different materials which inherently have different vibration characteristics.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6454250 to Ribeiro

US 20030226949 to Cain et al.

US 6714405 to Jitsukawa

US 20040090741 to Lee

The above patents disclose vibration damping assemblies and mounting assemblies.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN M. MARSH whose telephone number is (571)272-6819. The examiner can normally be reached on 8:30 am - 7:00 pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J Allen Shriver can be reached on 571-272-6698. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. M. M./
Examiner, Art Unit 3632
October 5, 2010

/Terrell Mckinnon/
Supervisory Patent Examiner, Art Unit 3632